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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,978	10/20/2003	Yukitomo Yuhara	371312002200	8658

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MORRISON & FOERSTER LLP  
1650 TYSONS BOULEVARD  
SUITE 300  
MCLEAN, VA 22102

EXAMINER

POLLICOFF, STEVEN B

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/687,978	<b>Applicant(s)</b> YUHARA, YUKITOMO	
	<b>Examiner</b> Steven B. Pollicoff	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 2/07/06.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 4-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/03/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 4 and 5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species II, there being no allowable generic or linking claim. Election of Species I directed to claims 1-3 was made **without** traverse in the reply filed on 2/07/06.

### ***Claim Objections***

2. Claim 2 and 3 are objected to because of the following informalities: See claim 2, line 5. "...an detachable projection" should read "a detachable projection. Because claim 3 depends from claim 2, claim 3 is also objected to until correction is made. Appropriate correction is required.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

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USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of copending Application No. 10/670,770. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application broadly includes all the limitations disclosed in the present application. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See MPEP § 804.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(a) as being anticipated by Yukitomo (JP Pub No 2002101949).

With respect to claim 1, Yukitomo discloses a cosmetic case, comprising a case body (Yukitomo Fig 1, reference 11), an associated lid (Fig 1 reference number 12) opening and closing the case body, an ornamental exchangeable cover (reference number 15) replaceably attached to the lid, a slide engagement member (Fig 1, reference number 10) provided cooperatively between the lid and the exchangeable cover to permit the exchangeable cover to slidably fit on the case body and a fastening member (reference number 21) provided cooperatively between the lid and the exchangeable cover to permit the lid to hold and release the exchangeable cover along its sliding direction.

With respect to claim 2, Yukitomo also discloses that the slide engagement member has a concave portion (Fig 1, reference number 22) provided in the exchangeable cover along a sliding direction of the cover and a convex portion (reference number 21) provided in the component (lid 12) without the concave portion and slidably fitted in the concave portion. Yukitomo also discloses that the fastening

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member is a detachable projection elastically deformable in the concave portion and detachably mated with the convex portion (see Fig 1 generally).

With respect to claim 3, it can generally be observed that Yukitomo discloses that the concave portion 22 has a dent that the convex portion is detachably fitted in (Fig 1, see the open space of 22 for convex portion 21 to slidably fit into).

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Landen et al., (US Pat No. 3,586,010).

With respect to claim 1, Landon discloses a cosmetic case, comprising a case body (Landen Fig 2, reference number 11), an associated lid (reference number 12) opening and closing the case body, an ornamental exchangeable cover (reference number 10; see also Column 1, lines 25-31) replaceably attached to the case body, a slide engagement member (Fig 6, reference number 34) provided cooperatively between the case body and the exchangeable cover to permit the exchangeable cover to slidably fit on the case body and a fastening member (reference number 36) provided cooperatively between the case body and the exchangeable cover to permit either the lid or the case body to hold and release the exchangeable cover along its sliding direction (see Figs 3-5 where the case body 11 is slidably removed from the cover 10 and look to see how fastening member 36 interacts with both the cover 11 and lid 12 to lock when closed; see also Column 3, lines 28-54).

With respect to claim 2, Landen also discloses that the slide engagement member has a concave portion (Fig 7, reference letter D between reference numbers 34 and 33) provided in the case body along a sliding direction of the cover (Fig 2) and a

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convex portion (the projections defining the groove at reference number 32 of cover 10) provided in the component (the cover 10) without the concave portion and slidably fitted in the concave portion. Landen also discloses that the fastening member is a detachable projection elastically deformable in the concave portion and detachably mated with the convex portion. Since Landen discloses that the container is made of plastic (Column 1, lines 20-24) and plastic is capable of being elastically deformable, it is reasonable to conclude that the fastening member is capable of being elastically deformable and detachably mated with the convex portion at groove 32 of cover 10 (Fig 3).

With respect to claim 3, Landen discloses that the concave and convex portions are provided in positions as desired along the sliding direction of the exchangeable cover and that the concave portion has a dent (Fig 7 at sidewall (block) 33, referring to the surface adjacent to sliding engagement member 34 where the D' measurement starts) the convex portion is detachably fitted in.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Lohrman et al., (US Pat No 5,115,930).

With respect to claim 1, Lohrman discloses a cosmetic case, comprising a case body (Lohrman Column 2, lines 7-9), an associated lid (Fig 1 reference number 10) opening and closing the case body, an ornamental exchangeable cover (reference number 14) replaceably attached to the lid, a slide engagement member (Fig 3, reference number 40) provided cooperatively between the lid and the exchangeable cover to permit the exchangeable cover to slidably fit on the case body and a fastening

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member (reference number 43) provided cooperatively between the lid and the exchangeable cover to permit the lid to hold and release the exchangeable cover along its sliding direction.

With respect to claim 2, Lohrman also discloses that the slide engagement member has a concave portion (Fig 5, see the portion of sliding engagement member 40 where it meets the projection fastening member 43) provided in the exchangeable cover along a sliding direction of the cover and a convex portion (Fig 3, reference number 31 at upper cap 30 of the lid 10) provided in the component (the upper cap 30) without the concave portion and slidably fitted in the concave portion. Lohrman also discloses that the fastening member is a detachable projection elastically deformable in the concave portion and detachably mated with the convex portion. Finally, Lohrman discloses that the fastening member is capable of being elastically deformable and detachably mated with the convex portion (Fig 1) such that the cover is interchangeable (Column 1, lines 8-10).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kitoh et al., (US Pat 4,580,586) discloses a vanity case with a lid, a case body, a slide engagement member and a fastening member. Marconi (US Pat No 6,173,837) discloses a case with exchangeable ornamental covers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. Pollicoff whose telephone number is (571)272-7818. The examiner can normally be reached on M-F: 7:30A.M.-4:00P.M.




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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JILA M. MOHANDESI  
PRIMARY EXAMINER